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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,686	03/10/2000	Takaaki Nagae	1046.1211/JDH	5906

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EXAMINER

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/522,686

Applicant(s)

NAGAE, TAKAAKI

Examiner

Nathan Hillery

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: Change of Address filed on 12/26/2000.
2. Claims 1 – 24 are pending in the case. Claims 1, 9, and 17 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 8/30/1999. It is noted, however, that applicant has not filed a certified copy of the 11-243872 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 6, 9 – 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 6 is unclear because the conditional statement "... when the display control unit cannot text-display characters written in the language ..." in lines 2 – 6 does not clearly cover all cases. For example, it is unclear what happens "when the display control unit" can "text-display characters written in the language ...". This rejection might be overcome if it included a determination means. Furthermore, the limitation "the display control unit" in lines 4 and 5 has insufficient antecedent basis.

7. Claims 9 recite the limitation "the input sentence" in line 5 claim. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 10 recites the limitation "the determination" in line 5 of claim. There is insufficient antecedent basis for this limitation in the claim.
9. **Regarding independent claim 17**, the claim incorporates substantially similar subject matter as claim 9, and is rejected along the same rationale.
10. **Regarding dependent claim 18**, the claim incorporates substantially similar subject matter as claim 10, and is rejected along the same rationale.
11. The remaining dependent claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend. Further, the article or use of the word "the" in the claims usually signifies a part or method that has previously been described or introduced in the claim. Corrections should be made by using "a" or "an".

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1 – 4, 8 – 12, 16 – 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. [US006119137A].
14. **Regarding independent claim 1**, Smith et al. teach "an electronic mail apparatus comprising: a transmission unit ...". In column 5, lines 63 – 66, Smith et al. disclose that *the server then proceeds to deliver the document to the intended recipient.*

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The specific delivery mechanism employed can include, for example email. Smith et al., however, do not explicitly teach “an image data forming unit ...”. Smith et al, does teach that the DDCS server dynamically converts the PDF document to a Group 4 compressed image using known techniques. (Column 4, lines 31 – 33). One with ordinary skill in the art at the time of the invention would know that converting from a PDF document, containing text and fonts (Column 1, lines 25 – 30), to an image involves “using a sentence input ... to form image data corresponding to the sentence”.

15. **Regarding dependent claim 2**, Smith et al. teach “a determination unit ...” by disclosing that *the document delivery server dynamically customizes the format of a document to be delivered, based on the capabilities of the recipient and the type of document to be delivered. (Abstract). Smith et al. further disclose that once the data format has been determined, and the recipient capabilities have been identified, the server then uses the mapping tables to conclude whether data conversion is required or appropriate ... such conversions are performed by a conversion engine. (Column 7, lines 34 – 41).*

16. **Regarding dependent claim 3**, Smith et al. do not explicitly teach, “... when the text data of the sentence is not correctly displayed in the destination of the electronic mail”. Smith et al. do teach that *the document delivery server dynamically customizes the format of a document to be delivered, based on the capabilities of the recipient and the type of document to be delivered. (Abstract). One with ordinary skill in the art at the time of the invention would know that if the recipient does not have the appropriate*

capabilities then the sentence would not be correctly displayed in the destination of the electronic mail.

17. **Regarding dependent claim 4**, Smith et al. disclose WordPerfect being displayed on a computer. (Figure 1).

18. **Regarding dependent claim 8**, Smith et al. disclose sending a PDF file to a server to be electronically delivered to another computer. However, Smith et al. do not explicitly teach that "the transmission unit transmits the image data as an attached file to the destination of the electronic mail." It was well known within the art to attach a PDF file to an electronic mail for transmission. (Figure 1). Also, it would have been obvious to one skilled in the art at the time of the invention to attach a PDF file to an electronic mail so that the receiver of the mail could download and save the attached file in its original formatting for future editing.

19. **Regarding independent claims 9 and 17**, the claims incorporate substantially similar subject matter as claim 1, and are rejected along the same rationale.

20. **Regarding dependent claims 10 and 18**, the claims incorporate substantially similar subject matter as claim 2, and are rejected along the same rationale.

21. **Regarding dependent claims 11 and 19**, the claims incorporate substantially similar subject matter as claim 3, and are rejected along the same rationale.

22. **Regarding dependent claims 12 and 20**, the claims incorporate substantially similar subject matter as claim 4, and are rejected along the same rationale.

23. **Regarding dependent claims 16 and 24**, the claims incorporate substantially similar subject matter as claim 8, and are rejected along the same rationale.

24. Claims 5, 7, 13, 15, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. [US006119137A] as applied to claims 1 – 4, 8 – 12, 16 – 20, and 24 above, and further in view of Flanagan et al. [US005966685A].

25. **Regarding dependent claim 5**, Smith et al. teach “an electronic mail apparatus according to claim 1”. However, Smith et al. fail to teach “... a translation unit ...” and “the transmission unit ...”. On the other hand, Flanagan et al. do teach *a system that incorporates machine translators and other software to translate messages in different languages*. (Abstract, Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Smith et al. and Flanagan et al. because such a combination would allow the DDCS of Smith et al. (fig 1) to transmit the PDF file to Paris in French as to make it easier for the user of the system.

26. **Regarding dependent claim 7**, Smith et al. do not teach “a synthesizing unit ...”. However, Flanagan et al. disclose that *each of the messages translated from another language version of the parallel discussion group may contain both the translated message and the original language text*. (Column 3, lines 6 – 10; Fig. 8, 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Smith et al. and Flanagan et al. because such a combination would allow the users of the system of Smith et al. to see both the translated text and the original text. Further, once the text is produced the system of Smith et al. could easily translate it to an image file as explained above.

27. **Regarding dependent claims 13 and 21**, the claims incorporate substantially similar subject matter as claim 5, and are rejected along the same rationale.

28. **Regarding dependent claims 15 and 23**, the claims incorporate substantially similar subject matter as claim 7, and are rejected along the same rationale.

Conclusion

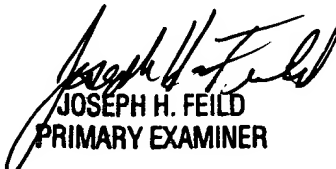
29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

O'Shea et al. US006189045B1 02/13/2001 03/26/1998

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on 8:30 - 5:00, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7238 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


JOSEPH H. FEILD
PRIMARY EXAMINER

NH
August 7, 2003